

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

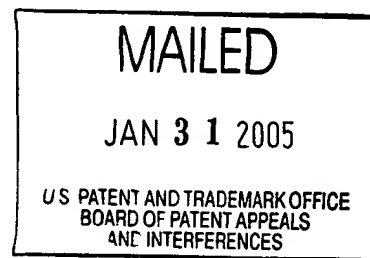
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WESLEY WILKINSON

Appeal No. 2004-2182
Application No. 09/915,570

HEARD: JANUARY 12, 2005



Before COHEN, NASE, and BAHR, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 21 through 59. These claims constitute all of the claims remaining in the application.

Appellant's invention pertains to a trolley control wheel assembly adapted to be fitted to a trolley having a longitudinal axis of travel and an array of castors having respective castor wheels, a trolley control wheel assembly adapted to be fitted to a trolley having a longitudinal axis of travel and an array of

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castors, a trolley having a longitudinal axis of travel, a cart having a longitudinal axis of travel, a trolley having a longitudinal axis of travel and having an array of castors on which the trolley can be moved from place to place in a general direction of the longitudinal axis of the trolley, a castored trolley control wheel, a trolley control wheel assembly adapted to be fitted to a trolley having a longitudinal axis of travel and an array of castors, a trolley having a longitudinal axis of travel, a trolley having a longitudinal axis of travel and having an array of castors on which the trolley can be moved from place to place in a general direction of the longitudinal axis of the trolley or otherwise, a castored trolley control wheel assembly, and a trolley control wheel assembly adapted to be fitted to a trolley having a longitudinal axis of travel and an array of castors having respective castor wheels. A basic understanding of the invention can be derived from a reading of exemplary claims 21, 22, 30, 31, 41, 42, 43, 44, 45, 46, and 47, respective copies of which appear in the APPENDIX to the revised appeal brief (Paper No. 19).

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As evidence of anticipation and obviousness, the examiner has applied the documents listed below:

Fullenkamp et al (Fullenkamp)	5,348,326	Sep. 20, 1994
Lloyd (Great Britain)	2,232,386	Dec. 12, 1990

Stabilus, Gas springs Technical information, May 1995 (Stabilus)

The following rejections are before us for review.

Claims 21 through 59 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Fullenkamp.

Claims 21 through 59 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lloyd in view of the admitted prior art (Stabilus).

The full text of the examiner's rejections and response to the argument presented by appellant appears in the answer (Paper No. 21), while the complete statement of appellant's argument can be found in the revised appeal brief (Paper No. 19).

In the revised appeal brief (page 4), appellant submits that claims 22 through 29, 35, and 45 through 57¹ do not stand or fall together in either of the anticipation and obviousness rejections on appeal. In the argument addressed to the anticipation rejection independent claims 21, 22, 30, 31, 36, and 41 through 47 are grouped together, whereas no specific claims are specifically mentioned in appellant's argument that relates to the obviousness rejection. Based upon the above, we focus our attention upon selected independent claim 21, in particular, and the argued claims that are indicated not to stand or fall in the respective anticipation and obviousness rejections. The remaining claims will stand or fall with selected claim 21.

OPINION

In reaching our conclusion on the anticipation and obviousness issues raised in this appeal, this panel of the board has carefully considered appellant's specification and claims,

¹ Based upon the argument advanced in the revised appeal brief (pages 10 and 11), it appears that claims 23 through 29 and claims 45 through 59 were intended to be referenced by appellant, not claims 22 through 29 and claims 45 through 57.

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the applied teachings,² and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Anticipation

We sustain the rejection of claims 21, 23 through 29, 35, and 46 under 35 U.S.C. § 102(e) as being anticipated by Fullenkamp, but do not sustain the anticipation rejection of claims 45 and 47. It follows that the anticipation rejection of claims 22, 30 through 34, and 36 through 44 is also sustained since these claims stand or fall with claim 21 as earlier indicated. Further, we procedurally do not sustain the anticipation rejection of claims 48 through 59.

² In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Selected claim 21 reads as follows.

A trolley control wheel assembly adapted to be fitted to a trolley having a longitudinal axis of travel and an array of castors having respective castor wheels, said assembly comprising:

a fixed wheel adapted to be disposed in use on a trolley in a vicinity of one of a load center of the trolley and a center of the array of castors, and

a self-contained gas strut independent of the castors and operable to provide controlled contact between the fixed wheel and a surface on which the trolley is intended to travel.

We share the examiner's point of view (answer, pages 3 and 4 and 6 through 9) that the trolley control wheel assembly of claims 21 is anticipated by the teaching of Fullenkamp.³ More particularly, it is quite clear to this panel of the Board, from

³ Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); and RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). However, the law of anticipation does not require that the reference teach specifically what an appellant has disclosed and is claiming but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

the explicit teachings of Fullenkamp (column 2, lines 8 through 10, lines 26 through 31; column 4, lines 34 through 48; and column 5, lines 11 through 18) that one skilled in the art at issue would recognize that the fixed wheel and self-contained gas strut of claim 21 respectively correspond to the first or second wheels 44, 46 and gas cylinder 62 of Fullenkamp (Fig. 3).

The argument presented by appellant as to the anticipation rejection does not persuade us that the examiner erred in making this rejection of independent claims 21, 22, 30, 31, 36, 41, 42, 43, and 44.

With regard claims 23 through 29, the broad argument made relative thereto does not reveal to us why one skilled in the art would not comprehend the content of these claims to be disclosed by the overall teaching of the Fullenkamp patent. Thus, we sustain the anticipation rejection of these claims.

As to claim 35, we are at loss to understand appellant's assertion that a lifting means "is not shown by Fullenkamp" in

light of the reference disclosure and the depiction in Fig. 2 of the reference. Thus, we sustain the anticipation rejection of claims 35.

With regard to claims 45 and 47, we are in accord with the view advocated by appellant that a plurality of fixed wheels with each having a self-contained gas strut is not taught by Fullenkamp. Considering the embodiments of Figs. 1 through 3 and Figs. 4 through 6 of Fullenkamp, and the respective claims of the patent related thereto (e.g., claims 10 and 11), it is at once apparent that Fullenkamp only teaches a compression spring for each of a plurality of wheels, and not a gas spring for each of a plurality of wheels. Thus, the anticipation rejection of claims 45 and 48 cannot be sustained.

Turning now to claim 46, we do not share appellant's appellant's view that this claim is patentable over Fullenkamp. Simply stated, we readily perceive that one skilled in the art would recognize in the Fullenkamp teaching castors 14 on each side of the gas cylinder 62 (Figs. 1 through 3). Thus, the rejection of claim 46 is sustained.

A review of the subject matter of claims 48 through 59 indicates to us that these claims raise indefiniteness and lack of description issues. It would be inappropriate on our part to speculate on the meaning of the language of these claims in an attempt to read these indefinite claims on prior art. See In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295-96 (CCPA 1962) and In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Accordingly, we procedurally do not sustain the anticipation rejection of these claims, and introduce new indefiniteness and lack of description rejections, infra. Our action should not be understood to make any statement as to the merits of any future rejection of any definite claims based upon the Fullenkamp reference.

Obviousness

We sustain the rejection of claim 21 under 35 U.S.C. § 103(a) as being unpatentable over Lloyd in view of the admitted prior art (Stabilus), but procedurally do not sustain the rejection of claims 48 through 59. The rejection of claims 22 through 47 is likewise sustained since all of these claims stand or fall with selected claim 21, as further explained below.

In applying the test for obviousness,⁴ and akin to the examiners' point of view (answer, pages 4 through 6 and 9 through 11), we reach the conclusion that it would have been obvious to one having ordinary skill in the art, from a combined assessment of the Lloyd and Stabilus disclosures, to replace the compression spring 43 (Fig. 3) in the trolley of Lloyd (Figs. 1 and 2) with a gas spring. From our perspective, one having ordinary skill in the art would have been motivated to make the specified modification simply for the reason of gaining the art recognized benefits of a gas spring vis-a-vis a mechanical spring, as clearly explained by Stabilus (page 1). We particularly note the full page pictorial showing in Stabilus of the many uses of gas springs, and most importantly, the known application of gas springs with a wheeled carriage and with a bed having castors. Accordingly, we sustain the obviousness rejection of claim 21.

Appellant's argument in the revised appeal brief (pages 6 through 10) does not convince us that selected claim 21 is

⁴ The test for obviousness is what the combined teachings of references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

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patentable over the combined teachings of Lloyd and Stabilus. For the reasons articulated above, and notwithstanding the differences between a mechanical spring and a gas strut as argued by appellant, the applied prior teachings as a whole would have been suggestive of the trolley control wheel assembly of claim 21. While appellant earlier indicated that claims 22 through 29, 35, and 45 through 57 do not stand or fall together as to the rejection under 35 U.S.C. § 103, the argument concerning these claims in the revised appeal brief (pages 10 and 11) does not even mention the references applied in the obviousness rejection and is solely based upon the Fullenkamp reference applied in the anticipation rejection. Thus, we are constrained to consider that these claims stand or fall with selected claim 21, the rejection of which we have sustained.

The obviousness rejection of claims 48 through 59 is procedurally not sustained for the reasons given, supra, as to these same claims in the anticipation rejection.

New Grounds of Rejection

Under the authority of 37 CFR 1.41.50(b), we introduce the following new rejections.

Claims 48 through 59 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite.⁵

When we consider the language of claims 48 through 59 in light of the underlying disclosure, we conclude that the metes and bounds thereof cannot be fairly ascertained. Comparable to

⁵ Relative to the requirements of 35 U.S.C. § 112, second paragraph, the court in In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970) stated that

[i]ts purpose is to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent, with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance.

Additionally, claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958 189 USPQ 149, 151 (CCPA 1976).

each of the claims, claim 48 specifies "traction force requirements". Appellant's disclosure does not address a traction force or the requirements thereof. It appears to us that the force discussed by appellant in the specification (page 3) is that which is exerted on the control wheel by the damped bias means. Thus, it is not clear what the claimed traction force or the requirements thereof denote, particularly for the claimed "a vertical position of said fixed wheel". The claim phrase "substantial function of a mass of the trolley" similarly cannot be understood from a review of the underlying disclosure. The inclusion of the word "substantial" modifying the term "function" adds a word of degree for which appellant's specification gives no guidance whatsoever as to its meaning. Thus, even if we were able to discern what a function of a mass of a trolley was, we would be unable to ascertain the meaning of a "substantial function". As to the overall recitation of a "substantial function of the mass of the trolley", we cannot understand what is intended thereby from the specification since it, at best, addresses not a function of a mass of the trolley, but bias means force in the context of the weight of an empty trolley and the load on the trolley. For the above reasons, claims 48 through 59 are determined to be indefinite in meaning.

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Claims 48 through 59 are rejected under 35 U.S.C. § 112, first paragraph, as lacking descriptive support in the originally filed application.⁶

A reading of appellant's disclosure reveals to us a lack of disclosure of the content of claims 48 through 59. We note that these claims were added to the application subsequent to the filing thereof. The amendment submitting the claims (Paper No. 8) offered no commentary by appellant as to any descriptive basis therefor in the underlying disclosure, and we do not discern any. Thus, the recitation of traction force requirements for a vertical position of a fixed wheel that are a substantial function of a mass of a trolley is new matter since it lacks descriptive support in the application as originally filed.

⁶ The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. Further, the content of the drawings may also be considered in determining compliance with the written description requirement. See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1562-63, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

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In summary, this panel of the board:

sustained the rejection of claims 21, 23 through 29, 35, and 46 under 35 U.S.C. § 102(e) as being anticipated by Fullenkamp, but did not sustain the anticipation rejection of claims 45 and 47, sustained the anticipation rejection of claims 22, 30 through 34, and 36 through 44 since these claims stand or fall with claim 21, and procedurally did not sustain the anticipation rejection of claims 48 through 59; and

sustained the rejection of claim 21 under 35 U.S.C. § 103(a) as being unpatentable over Lloyd in view of the admitted prior art (Stabilus), sustained the obviousness rejection of claims 22 through 47 since all of these claims stand or fall with selected claim 21, and procedurally did not sustain the obviousness rejection of claims 48 through 59.

The decision of the examiner is affirmed-in-part.

This decision contains new grounds of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September

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7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

37 CFR 41.50(b)



IRWIN CHARLES COHEN
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge



JENNIFER D. BAHR
Administrative Patent Judge

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